

REMARKS/ARGUMENTS

The claims are 1-4 and 8-13 with claims 14-15 having been withdrawn from consideration by the Examiner as being directed to a non-elected invention. Claim 1 has been amended to specify a thickness of more than 30 μm for the carrier layer, and claim 10 has been amended in view of the amendment to claim 1. This claim amendment is believed not to raise new issues that would require further consideration and/or search and would materially reduce or simplify the issues for appeal. Accordingly, it is respectfully requested that the claim amendment be entered, and reconsideration of all the claims is respectfully requested.

Claims 1, 2 and 8-10 were rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over *Hisao JP 08-324676*. The remaining claims under consideration by the Examiner were rejected under 35 U.S.C. 103(a) as being unpatentable over *Hisao* alone (claims 3 and 4), or further in view of *Cray et al. U.S. Patent Application Publication No. 2002/0061998* (claims 11 and 12), or *Cray et al.* and *Mazurek et al. U.S. Patent No. 5,650,215* (claim 13).

This rejection is respectfully traversed.

In Applicants' Amendment filed August 18, 2008, the differences between Applicants' self-adhesive surface protection film as recited in claim 1 as amended and *Hisao* were explained in detail; however, the Examiner took the position that the different purposes of use of the film known from the state of the art and the film being claimed cannot establish novelty or inventive activity. Furthermore, the Examiner alleged that there was a structure in *Hisao* that was in agreement with the structure being claimed by Applicants so that it must also be assumed that the properties are the same. It is respectfully submitted that the Examiner's position is unfounded.

As set forth in claim 1 as amended, Applicants' invention relates to a self-adhesive surface protection film for covering painted sheet metals and high-gloss sheet metals made of aluminum or stainless steel with a multi-layer laminate that is produced by means of coextrusion. During the coextrusion, the entire layer

structure is formed in a single method step, whereby the individual layers are brought out of exit openings of an extrusion die immediately adjacent to one another in the melted, liquid state. As a result of the formation of the entire film in a single method step, there are advantages with regard to the laminate strength because the border surfaces of the melted, liquid layers can melt into one another. Furthermore, additional steps for connecting the individual layers are eliminated, and for this reason, coextrusion is particularly efficient. It must be taken into consideration, however, that subsequently only the entire film, and not individual layers, can be subjected to mechanical subsequent treatment.

Making reference to *In re Thorpe*, 227 U.S.P.Q. 964, 966 (Fed. Cir. 1985) (cf. MPEP 2113), the Examiner defends the position that the characteristic of coextrusion, as a method characteristic ("product by process"), does not have an impact in the product itself, and thus the product being claimed does not differ from the one disclosed in *Hisao*. The decision in *Thorpe* cited by the Examiner, however, relates to a product in which, in the final analysis, there were no structural differences as compared to the

state of the art. It is respectfully submitted that this situation cannot be applied to Applicants' self-adhesive surface protection film as recited in claim 1 as amended. Rather, there are similarities with the other decision cited in MPEP 2113, namely *In re Garnero*, 412 F.2d 276, 279, 162 U.S.P.Q. 221, 223 (C.C.P.A. 1979) as noted as follows:

"The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where..., or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product." (citing *In re Garnero*).

For example, according to *Hisao*, the outer layer is formed by a biaxially oriented film. Because of the biaxial orientation, the polymer chains in the outer layer are oriented and stretched, and separate method steps are necessary for this biaxial orientation. Greater strength and stability are produced by means of the additional method step of biaxial orientation. See *Hisao* at paragraph [0005] which states, "The outer layer 2 is a

biaxially oriented film made of polyester, polypropylene, or nylon and it is a highly-rigid transparent film with a 5-30 μ thickness." Because the biaxial orientation leads, microscopically, to orientation and lengthening of the polymer chains, and macroscopically to a change in the mechanical properties, special and verifiable structural properties result from the biaxial orientation.

The possibility of modifying only one layer by means of biaxial orientation presupposes that lamination to additional layers takes place only subsequently. Production by means of coextrusion is therefore excluded, because in the case of such a production method, only all the layers of the film that has been formed can be exposed to subsequent treatment, particularly to biaxial orientation.

As has been explained previously, coextrusion must be considered an essential characteristic within the scope of Applicants' claim 1 as amended. In particular, there are structural and verifiable differences in comparison with the disclosure according to *Hisao*, which can easily be determined on

the product and lead to different mechanical properties. For example, according to *Hisao*, it is provided to stretch only one of the layers biaxially, in order to increase the stiffness.

According to *Hisao*, the disclosed film is intended for covering packagings of electronic components. For this purpose, the covering is welded onto the edge surface of a packaging and connected with thermally produced sealing seams. It is supposed to be possible to open this seal again by means of appropriately high tensile forces, without the cover film tearing. Accordingly, the film must have a great strength, and the biaxial orientation is provided for this purpose. Self-adhesive properties of the films are not described in *Hisao*. In contrast, according to Applicants' invention as recited in claim 1 as amended, the self-adhesive properties of the film specifically are those that are to be used. It is essential to Applicants' self-adhesive surface protection film as recited in claim 1, as amended, that the film adheres reliably to the surface to be protected, on the one hand, and can be removed without residues, on the other hand. Accordingly, the adhesive strength amounts to between 0.15 N/cm and 3.5 N/cm after storage at room temperature for 24 hours. On

the basis of the tensile forces, which are low in comparison with a heat-sealed connection, no increased strength of the film is required, and for this reason, it can be formed by means of coextrusion, in a single method step, as recited in claim 1 as amended.

To further distinguish Applicants' self-adhesive surface protection film as recited in the claims from *Hisao*, claim 1 has been amended to specify that the carrier layer has a thickness of more than 30 μm . In contrast, it is explained in *Hisao*, in paragraph [0005]: "If it [the thickness] exceeds 30 μ , it will be too rigid making the sealing unstable."

Thus, it is respectfully submitted that a person skilled in the art would be given no indication to use a thickness of more than 30 μm from *Hisao*. For this reason, a person skilled in the art also would not consider increasing the thickness above 30 μm within the scope of routine studies (cf. MPEP 2144.05).

In addition, there is also a direct connection between the

thickness now being claimed, on the one hand, and the production by means of coextrusion, on the other hand. For example, the biaxial orientation described in *Hisao* is neither provided for nor possible according to Applicants' self-adhesive surface protection film as recited in claim 1 as amended. Accordingly, the carrier layer has a lesser stiffness in comparison with the outer layer according to *Hisao*, and particularly for this reason, can also be structured with a greater thickness. In this connection, it must also be taken into consideration that when used as a surface protection film, improved protection of the covered surface can be achieved at a greater thickness of the carrier layer.

Accordingly, it is respectfully submitted that *Hisao* can neither anticipate nor render obvious Applicants' self-adhesive surface protection film as recited in claim 1 as amended.

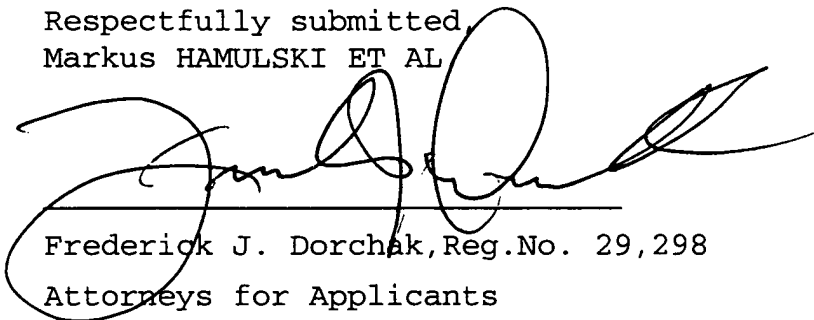
The remaining references to *Cray et al.* and *Mazurek et al.* which have been cited against certain dependent claims have been considered but are believed to be no more relevant. There is no disclosure or suggestion in either of these references to modify

Hisao in a manner to come up with a self-adhesive surface protection film as recited in Applicants' claim 1 as amended.

Accordingly, it is respectfully submitted that claim 1 as amended, together with claims 2-4 and 8-13 which depend directly or indirectly thereon, recite patentable and unobvious subject matter.

In summary, claims 1 and 10 have been amended. In view of the foregoing, withdrawal of the final action and allowance of this application are respectfully requested.

Respectfully submitted,
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